

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-19 remain active in the application subsequent to entry of this Amendment.

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention and to define the process using terminology accepted by the PTO.

Claim 18 has been amended to recite the specific solvent or solvents employed, the terminology being based upon the description of the invention at page 2, lines 11-13.

Claims 2-19 have been amended to replace the "characterized in that" expression with the more traditional "wherein".

All the claims stand rejected as "obvious" over Toru et al the Official Action stating that the only differences between the teachings of Toru et al and the invention under examination ("instant invention") resides in the fact that:

- formaldehyde (Toru et al) is used in lieu of paraformaldehyde (instant invention); and
- one trifluoromethyl group is present (Toru et al) is used in lieu of two trifluoromethyl groups (instant invention).

Actually, those variations should be considered by themselves sufficient to acknowledge that the instant invention does not derive from/is not suggested by Toru et al.

Moreover, as it is reported in the application, at page 1, lines 11-18, it is applicant's view the closest prior art is represented by U.S. 3,625,970 (of record) in view of Organic Syntheses, Vol. 1:188-190 (IDS submitted herewith).

U.S. 3,625,970 (column 4, lines 46-61) discloses the manufacture of the same compound of the instant invention by a reaction between a corresponding Grignard reagent and gaseous formaldehyde, prepared by thermal decomposition of paraformaldehyde as disclosed in the Organic Syntheses paper (above mentioned; *see* "2. Notes" second page, point 5). This paper specifically teaches that the use of paraformaldehyde on other Grignard reagents leads to poorer yields with respect of the use of formaldehyde.

Contrary to those teachings, applicant showed that the use of paraformaldehyde results in very good yields (>80%).

NARDELLO ET AL.
Appl. No. 10/575,485
November 26, 2007

In the light of the above, it is evident that applicant's invention is not derived at all from the prior art, which in fact would have lead the person skilled in the art away from the invention as defined in claims 1-19.

For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and allowance are solicited.

Should the examiner require further information or wish to discuss this application further, please contact the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



Arthur R. Crawford
Reg. No. 25,327

ARC:eaw
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100